

Appl. No. 10/027,751
 Resp./Amdt. dated Sep. 20, 2005
 Reply to Office Action of 07/27/2005

REMARKS/ARGUMENTS

There are no amendments to the specification, claims or drawings herein.

In the Claims, Claims 1-32 are pending. Claims 16-26 were allowed. Claims 1 and 27 were rejected. Claims 2-15 and 28-32 were objected to. Reconsideration is respectfully requested.

The Examiner rejected Claims 1 and 27 under 35 U.S.C. 102(e) as being anticipated by McCallister et al., U.S. Pat. No. 6,507,628 (hereinafter 'McCallister et al.'). The rejection was made final.

Applicant traverses the rejection of Claims 1 and 27 on the grounds that the Examiner failed to establish a *prima facie* case of anticipation with respect to McCallister et al. In particular, Applicant submits that McCallister et al. do not disclose, explicitly or implicitly, "each element of the claim under consideration" (*W.L. Gore & Associates v. Garlock*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983)) and/or do not disclose the claimed elements "arranged as in the claim" (*Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984)), as required by the Federal Circuit for *prima facie* anticipation under 35 USC 102.

On September 16, 2005, a telephone interview was conducted between Examiner Aditya S. Bhat and J. Michael Johnson, Agent for Applicant. During the telephone interview the language of Claims 1 and 27 was reviewed as was the scope and content of McCallister et al. Examiner Bhat acknowledged that upon further review, the disclosure by McCallister et al. does not anticipate or make obvious that recited in either of Applicant's Claims 1 or 27.

In particular, the Examiner agreed that McCallister et al. at least failed to disclose or suggest one or both of "compression of the receiver channel" and "the receiver channel being compressed", as recited in Claims 1 and 27, respectively. Furthermore, the Examiner agreed that McCallister et al. do not disclose or suggest either, "compensating for an effect that *compression of the receiver channel* has on a magnitude response and a phase response of the receiver channel", as recited in Applicant's Claim 1, or compensating for "an effect on the generated data caused by the receiver channel being compressed", as recited in Applicant's Claim 27.

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Hence, a *prima facie* case of anticipation with respect to McCallister et al. has not been established. In particular, the Examiner failed to show that there is “no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention” as required by the Federal Circuit. *Scripps Clinic & Research Found. V. Genentech Inc.*, 927 F.2d 1565, 18 USPQ 2d 1001, 1010 (Fed. Cir. 1991). Therefore, the final rejection of Claims 1 and 27 under 35 U.S.C. 102(e) is unsupported by facts in evidence and must be withdrawn.

Furthermore, the Examiner’s contentions in a *Response to Arguments* section of the present Office Action regarding claim interpretation breadth are respectfully rendered moot as a result of the telephone interview summarized above. In particular, during the telephone interview the Examiner acknowledged that McCallister et al. fail to disclose, “each element of the claim under consideration” (*W.L. Gore & Associates v. Garlock*, cited *supra*). Moreover, claim words or terms employed by Applicant in Claims 1 and 27 one or both of depend on the plain meaning of words or terms and are supported by a clear definition in Applicant’s specification, as originally filed. For example, the terms “compression of the receiver channel” (Claim 1) and “receiver channel being compressed” (Claim 27) are clearly defined by a discussion of ‘compression’ and ‘receiver channel’ in Applicant’s specification at Page 8, line 15, through Page 11, line 14. Given the detailed and thorough treatment of the concepts associated with receiver channel compression, Applicant submits that there should be no ambiguity regarding the meaning of any claim word or term.

Additionally, Applicant respectfully reminds the Examiner that “if the examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of patent”. *In re Oelrich*, 977, F.2d 1443, 24 USPQ 2d 1443 (Fed. Cir. 1992). Furthermore, the present Office Action is a third office action following an Appeal Brief filed by Applicant. Moreover, two Office Actions preceded the Appeal Brief filing. No amendments to the claims have been offered or necessitated by any of the aforementioned Office Actions.

Applicant appreciates the Examiner’s recognition of the allowability of Claims 16-26. Applicant further appreciates the Examiner’s recognition that Claims 2-15 and

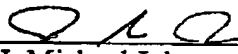
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28-32 would be allowable if rewritten in independent form. However, in view of a lack of *prima facie* support for rejecting base Claims 1 and 27, Applicant respectfully declines to amend Claims 2-15 and 28-32 at this time. Reconsideration is respectfully requested.

In summary, Claims 1-32 are pending. Claims 16-26 were allowed. Claims 1 and 27 were rejected and Claims 2-15 and 28-32 were objected to. For the reasons detailed above, rejected Claims 1 and 27 and objected to Claims 2-15 and 28-32 are in condition for allowance. It is respectfully requested that Claims 1-15 and 27-32 be allowed along with allowed Claims 16-26, and that the application be passed to issue at an early date.



Should the Examiner have any questions regarding the above, the Examiner is urged to contact the undersigned by telephone at the number given below, or John L. Imperato, Attorney for Applicant, Registration No. 40,026 at Agilent Technologies, Inc., telephone number (650) 485-5511.

Respectfully submitted,
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CERTIFICATE OF TRANSMISSION

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office on the date shown below.

 
 J. Michael Johnson Date

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